



389/02312 (OLD 158/02312) A02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: D. INGMAN

Serial Number: 10/053,401

Filed: November 9, 2001

Title: WRINKLE CREAM

Art Unit: 1616

Examiner: GEORGE, KONATA M

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#13
10/15/03

RESPONSE TO ORAL COMMUNICATION

Honorable Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's proposal to allow claims 1-28, 53-58 and 65 contingent upon cancellation of non-elected claims 29-52, 59-64 and 66, applicant authorizes cancellation of the non-elected claims.

However, applicant wants to bring to the Examiner's attention that in a Written Opinion established by the European Patent Office and mailed on July 29, 2003 for a related PCT Application, No PCT/IL02/00891 for the same invention, the PCT Examiner submits that the invention is anticipated by prior art. A copy of the Written Opinion is enclosed herewith. The prior art on which the Written Opinion is based was forwarded to the Examiner in supplementary IDSs filed on June 27, 2003 and August 25, 2003.

None of the cited prior art teaches the present invention of an emulsion in which gas is encapsulated in shells formed from hydrophilic and hydrophobic particles. The European Examiner supports his opinion by arguing that as soon as the essential ingredients of an emulsion are mixed together, gas is unavoidably encapsulated in a manner described by the present invention in the process of preparation of the emulsion. Since emulsions in prior art cited by the European Examiner comprise hydrophilic and hydrophobic materials, the European Examiner contends that the emulsions encapsulate gas as taught and claimed by the present invention and the prior art inherently anticipates the present invention.

Applicant feels that the European Examiner is wrong. It is very difficult to achieve proper mixing of a hydrophobic material with water to provide an aqueous emulsion and aqueous emulsions comprising a hydrophobic material are conventionally produced using a surfactant or

389/02312 (OLD 158/02312) A02

emulsifier to improve miscibility of the hydrophobic material in water. The prior art documents cited by the European Examiner that describe aqueous emulsions comprising a hydrophobic material illustrate prior art convention and incorporate a surfactant, emulsifier or water soluble polymer that couples to the hydrophobic material to improve miscibility of the hydrophobic material in water. However, a surfactant, emulsifier or suitable polymer operates to suppress encapsulation of gas in the manner described by the present invention and therefore the prior art does not inherently anticipate the present invention.

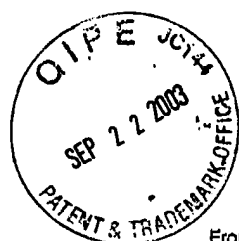
Respectfully submitted,
D. INGMAN

A handwritten signature in cursive script, appearing to read "Allan C. Entis", written over a horizontal line.

Allan C. Entis
Reg. No. 52,866

September 8, 2003
William H. Dippert, Esq.
Reed Smith LLP
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Tel: (212) 521-5400



PATENT COOPERATION TREATY

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From the:
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Fenster & Co.
05-08-2003
Docketed by: JS

WRITTEN OPINION

(PCT Rule 66)

| | | |
|---|--|--|
| Date of mailing (day/month/year) | | 29.07.2003 |
| Applicant's or agent's file reference 158/03292 | | REPLY DUE within 3 month(s) ✓ 29 Oct 03 from the above date of mailing 30 |
| International application No. PCT/IL02/00891 | International filing date (day/month/year) 07/11/2002 | Priority date (day/month/year) 09/11/2001 |
| International Patent Classification (IPC) or both national classification and IPC A61K7/00 | | |
| Applicant WIZCARE LTD. et al | | |

1. This written opinion is the first drawn up by this International Preliminary Examining Authority.
2. This opinion contains indications relating to the following items:
 - I ☒ Basis of the opinion
 - II ☐ Priority
 - III ☒ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - IV ☐ Lack of unity of invention
 - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - VI ☐ Certain document cited
 - VII ☐ Certain defects in the international application
 - VIII ☐ Certain observations on the international application
3. The applicant is hereby invited to reply to this opinion.


When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also: For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.
4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 09/03/2004.

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| Name and mailing address of the international preliminary examining authority:  European Patent Office - P.B. 6818 Patentlaan 2 NL-2280 HV Rijswijk - Pays Bas Tel. +31 70 340 - 2040 Tx: 31 851 epo nl Fax: +31 70 340 - 3018 | Authorized officer / Examiner Minas, S Formalities officer (incl. extension of time limits) Cherqui, E Telephone No. +31 70 340 2643 |
|---|--|

WRITTEN OPINION

International application No. PCT/IL02/00891

I. Basis of the opinion

1. With regard to the elements of the International application (Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed"):

Description, pages:

1-17 as originally filed

Claims, No.:

1-55 as originally filed

Drawings, sheets:

1-6 as originally filed

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:

WRITTEN OPINION

International application No. PCT/IL02/00891

☐ the drawings, sheets:

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)):

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been and will not be examined in respect of:

☐ the entire international application,

☒ claims Nos. 24-42,49-54,56,

because:

☐ the said international application, or the said claims Nos. relate to the following subject matter which does not require an international preliminary examination (*specify*):

☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. are so unclear that no meaningful opinion could be formed (*specify*):

☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.

☒ no international search report has been established for the said claims Nos. 24-42,49-54,56.

2. A written opinion cannot be drawn due to the failure of the nucleotide and/or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions:

☐ the written form has not been furnished or does not comply with the standard.

☐ the computer readable form has not been furnished or does not comply with the standard.

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N) Claims 1-6,9,10,18-20

Inventive step (IS) Claims 1-23

WRITTEN OPINION

International application No. **PCT/IL02/00891**

Industrial applicability (IA) Claims

2. Citations and explanations
see separate sheet

Re Item III

Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

As the applicant has not had a search report drawn up on the other inventions, the application will be prosecuted on the basis of the invention in respect of which a search has already been carried out, in other words the invention first mentioned in the claims. Therefor no establishment of opinion with regard to novelty, inventive step and industrial applicability will be given on the subject matter of claims 24-42, 49-54 and 56.

Re Item V

Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

Reference is made to the following documents:

- ✓ D1: US-A-5 185 155 (NESS JEREMY N ET AL) 9 February 1993 (1993-02-09)
cited in the application
- ✓ D2: EP-A-0 456 460 (UNILEVER PLC ;UNILEVER NV (NL)) 13 November 1991
(1991-11-13)
- ✓ D3: EP-A-0 478 326 (QUEST INT) 1 April 1992 (1992-04-01)
- ✓ D4: WO 92 15284 A (MICRO VESICULAR SYSTEMS) 17 September 1992
(1992-09-17)
- ✓ D5: PATENT ABSTRACTS OF JAPAN vol. 1996, no. 06, 28 June 1996 (1996-
06-28) & JP 08 053512 A (SHINTO PAINT CO LTD), 27 February 1996
(1996-02-27)
- ✓ D6: PATENT ABSTRACTS OF JAPAN vol. 015, no. 123 (C-0816), 26 March
1991 (1991-03-26) & JP 03 006269 A (HONNY CHEM IND CO
LTD;OTHERS: 01), 11 January 1991 (1991-01-11)
- ✓ D7: DATABASE WPI Section Ch, Week 2001 14 Derwent Publications Ltd.,
London, GB; Class D21, AN 2001-127030 XP002233771 & JP 2000 264815
A (SHINETSU CHEM IND CO LTD), 26 September 2000 (2000-09-26)

The document EP-A-0 288 419 (= D8; (COLGATE-PALMOLIVE COMPANY) 26
october 1988 (1988-10-26)) was not cited in the international search report. A copy of

the document is appended hereto.

Support (Article 6 PCT)

Claims 1-23, 42-48 and 55 are not supported by the description as required by Article 6 PCT, as their scope is broader than justified by the description and drawings.

As it seems to be clear from the description and claims 11 and 15, the emulsion of the present invention comprises as hydrophilic particles "oxide particles having a surfaces covered with polar radicals" (claim 11) and as hydrophobic particles "oxide particles having surfaces covered with non-polar radicals" (claim 15).

Since independant claims 1, 42 and 55 do not contain these features, they do not meet the requirements following from Article 6 PCT taken in combination with Rule 6.3(b) PCT that any independant claim must contain all the technical features essential to the definition of the invention and are therefor not supported by the description as required by Article 6 PCT.

Furthermore it seems very unlikely that any hydrophilic and any hydrophobic particle would perform the invention and a person skilled in the art could, using his common general knowledge, carry out the invention over the whole area claimed without undue burden and without needing inventive skill.

Novelty (Article 33(2) PCT)

As a general statement concerning the prior art cited against novelty, it is pointed out that during the process of preparation (and mixing) of emulsions it is unavoidable, that air inclusions in the emulsion occurs, unless specific measures of precautions are taken. Therefor, as soon as the essential ingredients are mixed together, air will be encapsulated and present according to the definition of the present invention.

Document D1 discloses methods encapsulation methods to form dispersion of micro-capsules. The inner layer of the shell encapsulating hydrophobic material is formed by silica particles, whereas the outer layer of the shell is formed by a gelling agent. The gelling step can be carried out by using a positively charged compound such as a positively charged polymer or a gum or a silicone which, as it attaches itself to the silica shell, is able to form an outer layer on the capsules (see column 2, line 5 to column 3,

line 31; also claims 1, 5 and 9).

The subject matter of claims 1-6 and 18 is therefore not new (Article 33(2) PCT).

Document D2 discloses cosmetic emulsions (claim 7, examples 1-4) comprising water-dispersible titanium dioxide coated with a material (e.g. Al_2O_3 or $\text{Al}_2\text{O}_5\text{Si}$) to impart a hydrophilic surface property to the particles and oil-dispersible titanium dioxide (optionally also coated) exhibiting a hydrophobic surface property. The particles have an average particle size of less than 100nm (page 2, lines 6 to 15).

The subject matter of claims 1, 2, 4, 5, 10-13, 15, 17, 18, 20 and 21 is therefore not new.

The present application does also not fulfill the requirements of Article 33(2) PCT, as the subject matter of claims 1 and 18 is not new in view of document D3 which discloses aqueous emulsion core-shell particles, having a hydrophobic inner part and a hydrophilic outer layer (column 3, line 56 to column 4, line 20; examples 17-21).

Document D4 discloses gas (claim 14) and oxygen (claim 4) carrying lipid vesicles. The lipid shell is structurally supported and stabilized by an additional aqueous soluble polymer (claim 20). The subject matter of claims 1, 2, 18 and 19 is therefore not new.

Document D5 discloses a method of producing a microgel by using emulsion particles composed of two layers: a core part consisting of a hydrophobic polymer and a shell part consisting of hydrophilic polymer. The subject matter of claims 1 and 18 is therefore not new.

Document D6 discloses a core-shell resin aqueous emulsion having a hydrophobic polymer core and a hydrophilic polymer shell. The subject matter of claims 1 and 18 is therefore not new.

Document D7 discloses cosmetic compositions (e.g. foundation cream) comprising hydrophilic silica micro particles coated with hydrophobic silica microparticles. The subject matter of claims 1, 2, 6, 18 is therefore not new.

Document D8 finally discloses a formulation comprising water, hydrophobic fumed silica (Aerosil R972) and hydrophilic fumed silica (Aerosil 200). The formulation allows the capacity to release active or nascent oxygen captured in the composition.

The subject matter of claims 1-3,4-6,9,10,19 and 20 is therefor not new.

Inventive step (Article 33(3) PCT)

In case the applicant is in the position to overcome the above raised novelty objections, the question of inventive step would still have to be considered.

Hereby also taking into account the remarks about the lack of support (see Item III), that up to now it seems very unlikely that any hydrophilic and any hydrophobic particle would perform the invention and a person skilled in the art could, using his common general knowledge, carry out the invention over the whole area claimed without undue burden and without needing inventive skill.

| | | |
|--|---|---------------------------------|
| INFORMATION DISCLOSURE CITATION (Use several sheets if necessary) | ATTY DOCKET NO. 389/02312 (old 158/02312) | SERIAL NO. 10/053,401 |
| | APPLICANT(S) Dov INGMAN | |
| | FILING November 9, 2001 | GROUP 1616 |

U.S. PATENT DOCUMENTS

[illegible]

FOREIGN PATENT DOCUMENTS

| EXAMINER INITIAL | | DOCUMENT NUMBER | DATE | COUNTRY | CLASS | SUB- CLASS | TRANSLATION | |
|---------------------|---|--------------------|-----------|---------|-------|---------------|-------------|----|
| | | | | | | | YES | NO |
| | 1 | EP 0 288 419 | 8 Jul '92 | EUROPE | | | | |
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|----------|-----------------|
| EXAMINER | DATE CONSIDERED |
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



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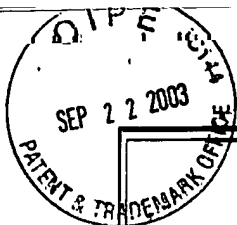
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Applicant: Dov Ingman
Serial No: 10/053,401
Filing Date: November 9, 2001
For: WRINKLE CREAM
Enclosures: (1) Transmittal Letter (in duplicate); (2) Response To Oral Communication (2 pages) w/copy of Written Opinion dated July 29, 2003 (8 pages) & corresponding PTO-1449 form (1 page);
(3) Acknowledgement Postcard.

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1616

| | | | |
|---|---------------------------------|-------------------------------|---|
| TRANSMITTAL LETTER (General - Patent Pending) | | | Docket No. 389/02312 (old 158/02312) |
| In Re Application Of: Dov INGMAN | | | |
| Serial No. 10/053,401 | Filing Date November 9, 2001 | Examiner GEORGE, KONATA M. | Group Art Unit 1616 |

Title: WRINKLE CREAM

TO THE COMMISSIONER FOR PATENTS:

Transmitted herewith is:

Response to Oral Communication (including copy of Written Opinion dated July 29, 2003 corresponding to PCT Application No. PCT/IL02/00891 and 1-page PTO-1449 form)

in the above identified application.

- ☒ No additional fee is required.
- ☐ A check in the amount of _____ is attached.
- ☒ The Director is hereby authorized to charge and credit Deposit Account No. _____ as described below.
 - ☐ Charge the amount of _____
 - ☒ Credit any overpayment.
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Signature

Dated: September 8, 2003

Maier FENSTER, Reg. No. 41,016

William H. Dippert, Esq.
Reed Smith LLP
599 Lexington Avenue, 29th Floor
New York, NY 10022-7650

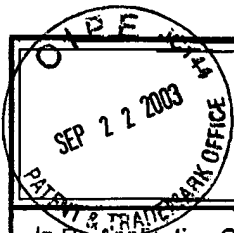
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TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
389/02312 (old 158/02312)

In Re Application Of: **Dov INGMAN**

| | | | |
|--------------------------|---------------------------------|-------------------------------|------------------------|
| Serial No. 10/053,401 | Filing Date November 9, 2001 | Examiner GEORGE, KONATA M. | Group Art Unit 1616 |
|--------------------------|---------------------------------|-------------------------------|------------------------|

Title: **WRINKLE CREAM**

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in the above identified application.

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- ☒ The Director is hereby authorized to charge and credit Deposit Account No. _____ as described below.
- ☐ Charge the amount of _____
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03-3419

Signature

Dated: September 8, 2003

Maier FENSTER, Reg. No. 41,016

William H. Dippert, Esq.
Reed Smith LLP
599 Lexington Avenue, 29th Floor
New York, NY 10022-7650

Tel: (212) 521-5400

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